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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,306

12/01/2003

James D. Ralph

F-303

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01/05/2007

SPINE MP

LERNER, DAVID, et al.

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WESTFIELD, NJ 07090

EXAMINER

SONNETT, KATHLEEN C

ART UNIT

PAPER NUMBER

3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/725,306

Applicant(s)

RALPH ET AL.

Examiner

Kathleen Sonnett

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/8/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION***Claim Objections***

Claims 5, 8, and 9 are objected to because of the following informalities: inconsistent wording. Claim 8 includes the limitation "wherein the engagement portion of the head separator is *laterally inwardly* tapered toward the distal end of the longitudinal shaft" (emphasis added). Only one tapered orientation for the head separator is disclosed in the instant specification and drawings (see fig. 2A and 2C). This taper (of the engagement portion of the head separator) is described in claim 5 as being *laterally outwardly* tapered toward the distal end of the shaft (see lines 3 and 5). Therefore, the claim should be amended to read that the engagement portion is laterally outwardly tapered toward the distal end of the shaft (in lines 2 and beginning of 5). Claim 9 also contains the phrase "*inwardly* tapered portion of the engagement portion" in line 7. This should read, "*laterally outwardly* tapered portion of the engagement portion". The examiner is assuming that the phrases "laterally outwardly tapered" and "laterally inwardly tapered" refer to the location of the distal taper, not the direction of the taper, since both are claimed as tapering toward the distal end of the shaft. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15, respectively, of U.S. Patent No. 6,669,699. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broader than the claims of U.S. Patent No. 6,669,699 and the invention of the claims of the U.S. Patent No. 6,669,699 fulfill all of the limitations of the claims of the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Freedland (U.S. 5,908,433). Freedland discloses a tool comprising a longitudinal shaft (20) having a distal end and a proximal end, a trial head (30, 40) at the distal end of the longitudinal shaft, the head having a proximal portion, the trial head being laterally separable from the longitudinal shaft, and a head separator (12) having an engagement portion, the engagement portion of the head separator being longitudinally movable relative to the longitudinal shaft and engagable by the longitudinal movement with the proximal portion of the trial head wherein

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when the engagement portion of the head separator engages the proximal portion of the trial head, the trial head laterally separates from the longitudinal shaft (col. 9 ll. 31-36).

Regarding claim 2, the trial head comprises first and second jaw members (30, 40) each having a distal end and a proximal end, the proximal end being the proximal portion of the trial head, the distal ends of the jaw members being hinged to one another (pin 32) at the distal end of the shaft so that the proximal ends of the jaw members are openable and closable about the shaft.

Regarding claim 3, see fig. 3 and 6.

Regarding claim 5, the proximal ends of the jaw members are laterally inwardly tapered toward the distal end of the shaft and the engagement portion of the head separator is laterally outwardly tapered toward the distal end (beveled sections 16 and 18) such that when the engagement portion engages the proximal end of the jaw members, the tapered portion of the engagement portion pushes the tapered portion of the jaw members laterally away from the longitudinal shaft (col. 9 ll. 9-13). Looking at each jaw member, the proximal tips (33, 43) are rounded and therefore the inside edge is tapered at the very tip. This tip engages the outwardly laterally outwardly tapered portion (16, 18) of the distal end of the shaft.

Regarding claims 6 and 7, the head separator comprises a longitudinal sleeve (12) having a longitudinal bore through which the longitudinal shaft is disposed so that the sleeve is translatable on the shaft, the sleeve having a distal end that includes an engagement portion (col. 9 ll. 31-36).

Regarding claim 8, the proximal portion of the trial head is laterally inwardly tapered toward the distal end of the shaft and the engagement portion of the head separator is laterally *outwardly* tapered toward the distal end (beveled sections 16 and 18) such that when the engagement portion engages the proximal portion, the tapered portion of the engagement

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portion pushes the tapered portion of the trail head laterally away from the longitudinal shaft (col. 9 ll. 9-13). Looking at each jaw member, the proximal tips (33, 43) are rounded and therefore the inside edge of each jaw member is tapered at the very tip. This tip engages the outwardly laterally outwardly tapered portion (16, 18) of the distal end of the shaft.

Regarding claim 9, the trial head comprises first and second jaw members, each having a distal end and a proximal end, the proximal end being the proximal portion of the trial head, the distal ends of the jaw members being hinged to one another (pin 32) at the distal end of the shaft so that the proximal ends of the jaw members are openable and closable about the shaft. The tapered portion of the engagement portion pushes the tapered portion of the jaw member laterally away from the longitudinal shaft.

Regarding claim 10, the distal ends of the jaw members are hinged to one another at the distal end of the shaft so that the proximal ends of the jaws are openable and closable about the shaft (see fig. 1, fig. 13, and col. 9, ll. 31-36).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. 862,712 to Collins discloses a tool that has a clamshell-style head mounted on the distal end of a longitudinal shaft.

U.S. 5,599,279 to Slotman et al. disclose a surgical tool for spinal procedures having a trial head at the distal end of a shaft. The jaws are hinged together at their proximal end by a hinge that allows the first and second jaw members to angulate with respect to one another at the hinge and that allows the distal ends of the jaw members to separate from one another at the hinge.

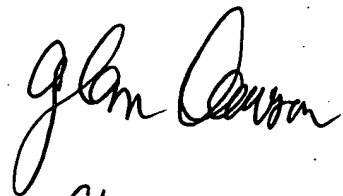
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Sonnett whose telephone number is 571-272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 12/19/2006


Glenn K. Dawson
Primary Examiner
AU 3731